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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/566,722	02/02/2006	Kenji Watanabe	TCP-004	9199
32628	7590	01/02/2009	EXAMINER	
KANESAKA BERNER AND PARTNERS LLP			RAO, G NAGESH	
1700 DIAGONAL RD				
SUITE 310			ART UNIT	PAPER NUMBER
ALEXANDRIA, VA 22314-2848			1792	
			MAIL DATE	DELIVERY MODE
			01/02/2009	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/566,722	WATANABE ET AL.	
	Examiner	Art Unit	
	G. NAGESH RAO	1792	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 14 November 2008.
 2a) This action is **FINAL**. 2b) This action is non-final.
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-15 is/are pending in the application.
 4a) Of the above claim(s) 3-15 is/are withdrawn from consideration.
 5) Claim(s) _____ is/are allowed.
 6) Claim(s) 1-2 is/are rejected.
 7) Claim(s) _____ is/are objected to.
 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
 10) The drawing(s) filed on 02 February 2006 is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ . |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>2/20/06</u> . | 6) <input type="checkbox"/> Other: _____ . |

DETAILED ACTION

Election/Restrictions

1) Claims 3-15 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on 11/14/08.

Applicant's election without traverse of claims 1-2 (Group I) in the reply filed on 11/14/08 is acknowledged.

Claim Objections

2) Claims 1-2 are objected to because of the following informalities: It is unclear whether the BN crystal is subjected to UV light emissions falling within the 210-220 nm range with a far limit range of 235nm, or whether the crystal embodies the characteristics of 210-220 nm and far limit range of 235 nm in the UV spectrum. Clarification with respect to the scope is greatly appreciated and appropriate correction is required. For purposes of examination, examiner is basing the range as a limiting characteristic of the crystalline BN material itself.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3) A broad range or limitation together with a narrow range or limitation that falls within the broad range or limitation (in the same claim) is considered indefinite, since the resulting claim does not clearly set forth the metes and bounds of the patent protection desired. See MPEP § 2173.05(c). Note the explanation given by the Board of Patent Appeals and Interferences in *Ex parte Wu*, 10 USPQ2d 2031, 2033 (Bd. Pat. App. & Inter. 1989), as to where broad language is followed by "such as" and then narrow language. The Board stated that this can render a claim indefinite by raising a question or doubt as to whether the feature introduced by such language is (a) merely exemplary of the remainder of the claim, and therefore not required, or (b) a required feature of the claims. Note also, for example, the decisions of *Ex parte Steigewald*, 131 USPQ 74 (Bd. App. 1961); *Ex parte Hall*, 83 USPQ 38 (Bd. App. 1948); and *Ex parte Hasche*, 86 USPQ 481 (Bd. App. 1949). In the present instance, claim 2 recites the broad recitation "...at a wavelength of 210-220 nm...", and the claim also recites "...remarkably at 215 nm" which is the narrower statement of the range/limitation.

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the “right to exclude” granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

- 4) Claims 1-2 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-2 of copending Application No. 11/988,033. Although the conflicting claims are not identical, they are not patentably distinct from each other because the inventive scope between both claimed inventions is very similar. The claims of the ‘033 application recite the following:

1. Far-UV luminescence high-purity hexagonal boron nitride monocystalline powder formed by sp₂ bonds of nitrogen atoms and boron atoms and expressed by general formula BN and having a characteristic property of emitting far-UV light showing an emission peak at wavelength between 224 nm and 233nm, remarkably at 227 nm, with high luminance when excited by excitation means.

2. The far-UV luminescence high-purity hexagonal boron nitride monocystalline powder according to claim 1, characterized in that the concentration of oxygen impurities of the far-UV luminescence high-purity hexagonal boron nitride monocystalline powder is set to be not greater than 10¹⁸ atoms per 1 cubic centimeter.

Examiner does not see a substantial difference between the currently claimed product claims as compared to the product claims above in the ‘033 application.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 102

- (f) he did not himself invent the subject matter sought to be patented.
- 5) Claims 1-2 are rejected under 35 U.S.C. 102(f) because the applicant did not invent the claimed subject matter. According to the article, submitted in the IDS (2/2/06), entitled “Direct-bandgap properties and evidence for ultraviolet lasing of

hexagonal boron nitride single crystal” authored by Watanabe et al, there are three authors on the published research paper. Whereas the currently claimed application has seven inventors listed. It is unclear if the other four inventors listed intellectually contributed to the creation of this “currently” claimed invention. The paper discloses the product of hexagonal boron nitride crystal with the UV light emission characteristics as currently claimed. Therefore clarification is required as to who are the true inventors of this currently claimed invention.

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

6) Claims 1-2 are rejected under 35 U.S.C. 102(a) as being anticipated by “Direct-bandgap properties and evidence for ultraviolet lasing of hexagonal boron nitride single crystal” authored by Watanabe et al..

Watanabe et al teach a hexagonal boron nitride single crystals that have far UV light emission characteristics that fall within a 235 nm range and more specifically within the 210-220 nm range (See Page 404 1st paragraph, as well Figures 1-4, which depict the various spectrum ranges for the HBN crystal).

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary.

Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35

U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7) Claims 1-2 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Bundy (US Patent No. 3,212,851).

Bundy 851 teaches that is well known for hexagonal boron nitride single crystals to exist (See Col 1 Lines 8-10).

However Bundy 851 does not explicitly teach the hexagonal BN single crystal having the capability of emitting within the 210-220 nm UV light emission range, or more so at the far end of the 235 nm.

It would be obvious to one having ordinary skill in the art at the time of the present invention to recognize this as most likely an inherent characteristic of single crystalline material.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to G. NAGESH RAO whose telephone number is (571)272-2946. The examiner can normally be reached on 8:30AM-5PM (INDEPENDENT FLEX SCHEDULE).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, MIKHAIL KORNAKOV can be reached on (571)272-1303. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

GNR
/G. Nagesh Rao/

/Robert M Kunemund/

Primary Examiner, Art Unit 1792

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